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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/058,732

01/30/2002

Hirohisa Imai

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08/05/2008

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EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3626

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/058,732	<b>Applicant(s)</b> IMAI ET AL.	
	<b>Examiner</b> LENA NAJARIAN	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,17-24,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,17-24,27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 6/23/08.

Claims 1 and 15 have been amended. Claims 25 and 26 have been cancelled.

Claims 1, 3-15, 17-24, and 27-28 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, 7-13, 15, 17-19, 21-24, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarkson (US 2003/0046305 A1) in view of Kraftson et al. (6,151,581) in view of Jeacock et al. (6,014,630), and further in view of Tipirneni (US 6,381,029 B1).

(A) Referring to claim 1, Clarkson discloses a communication system for providing information of a medical doctor's questions to patients, said communication system comprising a medical doctor terminal apparatus (abstract, para. 50, and Fig. 2 of Clarkson), a patient terminal apparatus (para. 50 and Fig. 2 of Clarkson), and a database server apparatus for storing question sets for the medical doctor's questions to patients, said medical doctor terminal apparatus, said patient terminal apparatus and said database server apparatus are

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connected to each other through a communication network (abstract, para. 50, para. 23, para. 27, and Fig. 2 of Clarkson),

wherein said patient terminal apparatus comprises:

first interface means for establishing a network connection and data communication between the database server apparatus and said patient terminal apparatus via the communication network (Fig. 2 of Clarkson);

displaying means for displaying questions for the medical doctor's questions to patients by executing the question programs generated by said generating means (abstract, para. 73, para. 79, and Fig. 1-2, para. 99, para. 102-103, and para. 110 of Clarkson);

entering means for entering answer data to the displayed questions (para. 50, para. 23, para. 27, and Fig. 1-2 of Clarkson); and

transmitting means for transmitting the entered answer data to said database server apparatus, and storing the transmitted answer data in said database server apparatus (abstract, para. 50, para. 23, para. 27, and Fig. 1-2 of Clarkson); and

wherein said medical doctor terminal apparatus comprises second receiving means for receiving the answer data stored in said database server apparatus by accessing said database server apparatus, and displaying the received answer data (abstract, para. 50, para. 23, para. 27 of Clarkson).

Clarkson does not expressly disclose:

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first receiving means for receiving at least one question set from said database server apparatus, each question set being dependent on a particular patient among a plurality of patients;

template storing means for storing template question programs which correspond to predetermined answer forms and are not dependent on a particular patient;

generating means for generating question programs which are dependent on a particular patient among a plurality of patients using a patient-independent template program, by inserting question sets received from said database server apparatus into the template question programs;

second interface means for terminating the network connection and data communication between the database server apparatus and said patient terminal apparatus; and

wherein the patient dependent question programs are not transmitted through the communication network.

Kraftson discloses first receiving means for receiving at least one question set from said database server apparatus, each question set being dependent on a particular patient among a plurality of patients (col. 6, lines 19-46 of Kraftson).

Jeacock discloses template storing means for storing template question programs which correspond to predetermined answer forms and are not dependent on a particular patient; generating means for generating question programs which are dependent on a particular patient among a plurality of patients using a patient-independent template program, by inserting question

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sets received from said database into the template question programs, and wherein the patient dependent question programs are not transmitted through a communication network (col. 1, lines 41-58, col. 2, lines 31-48, and col. 5, line 52 – col. 6, line 4 of Jeacock).

Tipirneni discloses terminating the network connection and data communication (col. 6, lines 28-34 of Tipirneni).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Kraftson, Jeacock, and Tipirneni within Clarkson. The motivation for doing so would have been to elicit pertinent information (col. 7, lines 60-67 of Kraftson), to be able to customize the templates as necessary for any unique situations of the patient (col. 1, lines 41-58 of Jeacock), and to ensure confidentiality and security (col. 6, lines 19-46 of Tipirneni).

(B) Claims 3-5, 7-13, and 27-28 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(C) Claims 15, 17-19, and 21-24 repeat the same limitations as those of claims 1, 3-5, and 7-13, and are therefore rejected for the same reasons given for those claims and incorporated herein.

4. Claims 6, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarkson (US 2003/0046305 A1) in view of Kraftson et al. (6,151,581) in view of Jeacock et al. (6,014,630), in view of Tipirneni (US 6,381,029 B1), and further in view of Bair et al. (6,108,665).

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(A) Claims 6, 14, and 20 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

### ***Response to Arguments***

5. Applicant's arguments filed 6/23/08 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6/23/08.

(A) Applicant argues that in the Jeacock reference, the predefined templates only present information prepared in advance to the user, not questions regarding a medical condition from a doctor. Thus, the Jeacock reference is not implemented for a back-and-forth communication between a doctor and patient, as in the present invention (as recited in independent claim 1). Jeacock is different from the present invention because the default templates in Jeacock only provide information regarding a medical procedure.

(1) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the questions are regarding a medical condition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Jeacock's question programs are not used for providing medical doctor's questions to patients, the test for

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obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the Examiner respectfully submits that Clarkson teaches medical doctor's questions to patients (see para. 99, para. 102-103, and para. 110 of Clarkson).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./  
Examiner, Art Unit 3626  
In  
7/28/08

/Robert Morgan/  
Primary Examiner, Art Unit 3626